

Appl. No. : 10/754,919
Filed : January 10, 2004

REMARKS

A. Introduction

Applicant respectfully requests reconsideration and allowance of this application. Claims 1-28 are pending in the application. Claims 8-19 have been withdrawn from consideration. Applicant has amended Claim 20. Applicant has added new Claims 21-28. Applicant's claim amendments and additions are shown on the pages above following the heading AMENDMENTS TO THE CLAIMS. On these pages, the deletions are struck through while the insertions are underlined.

Applicant submits that this application is now in condition for allowance, and Applicant earnestly requests such action. Below, Applicant addresses each of the Examiner's rejections.

B. All Claims are Patentable Over Hyodoh

The Examiner rejected Claims 1-7 and 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0040771A1 to Hyodoh. Applicant respectfully submits that the claims are allowable over Hyodoh.

As the Examiner well knows, an anticipation rejection under § 102 requires that "every element of the claimed invention must be identically shown in a single reference." *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Claim 1 recites "a temporary absorbable venous occlusive stent, comprising: a stent body; a bio-absorbable material associated with said body; and closure means for blocking blood flow past said stent when implanted in a vein."

Means-plus-function claims, under 35 U.S.C. 112, paragraph 6, are evaluated with respect to the corresponding structure described in the specification. The Examiner fails to identify the structures described in the specification that correspond to the closure means for blocking blood flow. Moreover, the Examiner fails to specifically identify any structures in Hyodoh that perform the claimed function and that have the same structures as described in the specification, or equivalents thereof. The Examiner seems to suggest that the monofilament loop performs the same functions and is the same as, or equivalent to, the structures described in the specification for blocking blood flow.

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MPEP section 2182 states the following with regard to the examination of means-plus-function claims: "the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim." (Emphasis Added.) The structure of Hyodoh referenced by the Examiner, however, does not perform the function as recited in Claim 1. The cited monofilament loop fails to satisfy the function of blocking blood flow. The monofilament loop in Hyodoh is part of a retrievable filter. Even if the monofilament loop were pulled to reduce the diameter of the filter at the proximal end as taught by Hyodoh, the blood flow would not be blocked, but would continue to flow through the filter. Accordingly, because the monofilament loop of Hyodoh does not perform the identical function of blocking blood flow, Applicant respectfully submits that the rejection should be withdrawn.

Claim 20, as amended, recites "a temporary absorbable venous occlusive stent, comprising: a stent body comprising a bio-absorbable material; and an adjustable closure device associated with said stent body, said closure device comprising: an open configuration in which said closure device permits blood flow past said stent body; and a blocking configuration in which said closure device forms a wall that blocks blood flow past said stent body."

The Examiner takes the position that pulling on the monofilament loop of Hyodoh closes that end of the retrievable filter. However, as stated above, pulling the monofilament loop of Hyodoh's retrievable filter does not block blood flow. Therefore, the monofilament loop of Hyodoh does not have a closure device having both an open configuration and a blocking configuration as described in amended Claim 20. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 20.

Dependent Claims 2-7, which include the unique features of independent Claim 1, recite additional features of particular advantage and utility. Moreover, Claims 2-7 are allowable for substantially the same reasons presented above.

In summary, Hyodoh does not disclose or suggest all of the limitations of Claim 1 or Claim 20, let alone the unique combinations of features recited by Claims 2-7. Accordingly, Applicant respectfully requests that the Examiner withdraw these rejections.

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C. New Claims

New dependent Claims 21-28 have been added. Claims 21-27 depend from Claim 20, and thus include the unique features of independent Claim 20. Claim 28 depends from Claim 1, and thus includes the unique features of independent Claim 1. These dependent claims also recite additional features of particular advantage and utility not disclosed by Hyodoh. For example, in dependent Claim 28, the closure means blocks blood flow to a degree sufficient to induce clotting and fibrosis at an implantation site of said stent body. Moreover, Claims 21-28 are allowable for substantially the same reasons presented above.

D. Conclusion

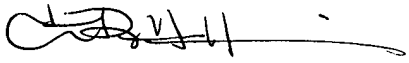
For the reasons presented above, Applicant respectfully submits that this application, as amended, is in condition for allowance. If there is any further hindrance to allowance of the pending claims, Applicant invites the Examiner to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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